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OFFICE OF PETITIONS

In re Application of	:	
Sreenivas Subramoney, Richard	:	
Hudson, Mauricio J. Serrano, Ali-	:	
Reza Adl-Tabatabai	:	DECISION REFUSING
Application No. 10/749,425	:	STATUS UNDER § 1.47(a)
Filing Date: December 31, 2003	:	
Attorney Docket No. 30320/17231	:	

This is in response to the "STATEMENT OF FACTS UNDER 37 C.F.R. §1.47(a)," filed September 7, 2004.

The petition under 37 CFR 1.47(a) is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventors.

Failure to respond will result in abandonment of the application.
Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed on December 31, 2003, without an executed oath or declaration. Accordingly, on May 3, 2004, the Office of Initial Patent Examination mailed a Notice to File Missing Parts, requiring an executed oath or declaration,

and a surcharge for its late filing. In response, applicants filed the instant petition on September 7, 2004, made timely by obtaining a two month extension of time and including a certificate of mailing dated September 3, 2004. Accompanying the petition was a declaration executed by joint inventors Sreenivas Subramoney, Richard Hudson, and Ali-Reza Adl-Tabatabai, but with the signature block for joint inventor Mauricio J. Serrano left blank.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor(s) cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 37 CFR 1.63; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor(s). The instant petition does not satisfy requirement (1).

As to requirement (1), there has been no showing that non-signing inventor Serrano was presented with the application papers (specification, claims, drawings, oath or declaration). Rather, the petition only establishes that Serrano was forwarded a copy of the declaration and assignment forms. Regarding this, the Manual of Patent Examining Procedure states:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers.

It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. In re Gray, 115 U.S.P.Q. 80 Comm'r Pat. 1956).

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient.¹

¹ MPEP 409.03(d).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

By FAX: (703) 872-9306
Attn: Office of Petitions

Telephone inquiries concerning this decision may be directed to the undersigned at (571)272-3207.

Cliff Congo

Cliff Congo
Petitions Attorney
Office of Petitions